IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	Robert A. Marshall, et al.
Serial No.:	10/025,599
Filing Date:	December 18, 2001
Confirmation No.	7923
Group Art Unit:	2619
Examiner:	Michael J. Moore, Jr.
Title:	***Method and System for Self-Testing a Line Card***

Mail Stop - AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The following Pre-Appeal Brief Request for Review ("Request") is being filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 ("OG Notice"). Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal. The Applicants respectfully request reconsideration of the rejections of the claims in light of the remarks set forth below.

REMARKS

Applicants contend that the rejections of Claims 1-4, 7-16, and 45-66 contain clear legal and factual deficiencies, as described below. Applicants request a finding that these rejections are improper and that the claims are allowable.

Rejections of Claims 1-4, 7-16, and 45-66

The Final Office Action mailed January 10, 2008 ("Final Office Action") rejects Claims 1-4, 7-16, and 45-66 using a variety of references, including U.S. Patent No. 6,909,781 to Itri ("*Itri*"). Applicants respectfully traverse these rejections.

The Final Office Action relies on an isolation circuit 804 of *Itri* as teaching "terminating the combined channel with a termination circuit, the termination circuit having an impedance and comprising one or more resistors and one or more capacitors" of Independent Claim 45. *See Final Office Action*, Page 7. This, however, is incorrect.

First, according to *Itri*, the isolation circuit 804 merely performs "***DC isolation*** from the DSL line 110." *See Itri*, Col. 7, Lines 62-64 (emphasis added). In doing so, the isolation circuit of *Itri* "***pass[es] through***" the "signals carried by tip input 851 and ring input 852" to multiple input device 810. *See Itri*, Col. 7, Lines 60-62 (emphasis added). Therefore, since *Itri* expressly discloses that the signals ***pass through*** the isolation circuit 804 of *Itri* to the multiple input device 810, the isolation circuit 804 of *Itri* fails to disclose, teach, or suggest "***terminating*** the combined channel with a termination circuit" of Claim 45 (emphasis added).

Despite *Itri's* disclosure that the signals are "pass[ed] though" the isolation circuit, the Final Office Action contends that the isolation circuit 804 of *Itri* "terminates ring and tip signals fed from DSL line 110." *See Final Office Action*, Page 18. In the Response to the Office Action filed March 7, 2008 ("Response"), Applicants pointed out that not only does the Final Office Action ***fail to provide any support for such a contention***, but, contrary to such a contention, *Itri* clearly states "***the signals*** carried by tip input 851 and ring input 852 ***pass through an isolation circuit 804***." *See Response*, Pages 11-12 (quoting *Itri*, Col. 7, Lines 60-62) (emphasis added). In response, the Advisory Action mailed March 31, 2008 ("Advisory Action") attempts to clarify this contention by stating that the isolation circuit 804 of *Itri* "terminates ring and tip signals 823 and 824 fed from DSL line 110 at the tap points

shown on the DSL line 110 in Figure 8." *See Advisory Action*, continuation sheet. This contention, however, is also incorrect.

For example, *Itri* clearly states that "[t]he tip input 851 carries a signal from the tip conductor ('tip') 823 . . . [t]he ring input 852 carries a signal from the ring conductor ('ring') 824 . . . [and] the signals carried by tip input 851 and ring input 852 ***pass through*** an isolation circuit 804." *See Itri*, Col. 7, Lines 49-62 (emphasis added). Thus, the ring and tip signals 823 and 824 fed from DSL line 110 are merely passed through the isolation circuit 804—***not terminated***. *See Itri*, Fig. 8 (illustrating that the signals from tip conductor 823 and ring conductor 824 ***pass through isolation circuit 804*** while being carried by tip input 851 and ring input 852, and are input into multiple input device 810).

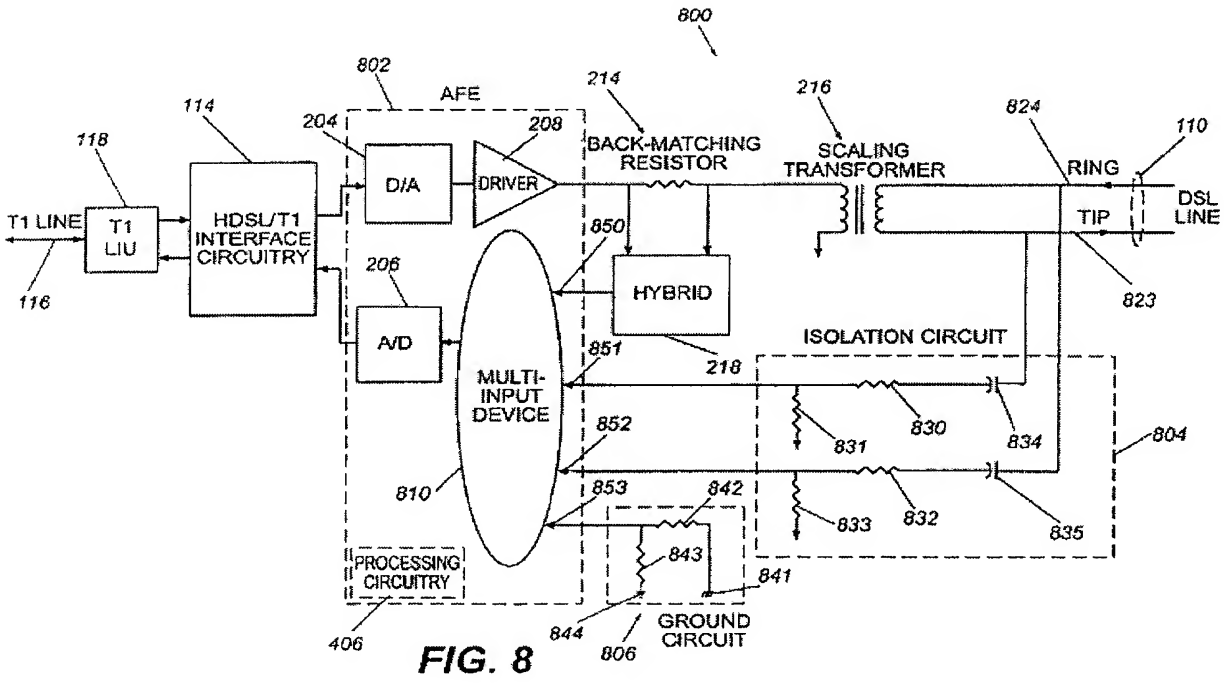

FIG. 8

As a result, *Itri* clearly fails to disclose, expressly or inherently, "***terminating*** the combined channel with a termination circuit" of Claim 45 (emphasis added). For at least this reason, Applicants contend that the rejection of Independent Claim 45 is improper, as are the rejections of Claims 46-54 that depend therefrom. For analogous reasons, Applicants contend that the rejections of Independent Claims 1, 55, 60, 65, and 66 are improper, as are the rejections of Claims 2-4, 7-16, 56-59, and 61-64 that depend therefrom. Favorable action is requested.

The Interpretation of *Itri* is improper

According to the M.P.E.P., "[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." *See* M.P.E.P. § 2141.02(VI) (citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983)) (emphasis in original). Applicants respectfully submit that interpreting the isolation circuit of *Itri* as a "termination circuit" of Claim 45, as suggested at Page 18 of the Final Office Action, would completely disregard the ***limitations*** of *Itri*. For example, *Itri* clearly limits the isolation circuit to an entity that "pass[es] through" signals. *See Itri*, Col. 7, Lines 60-62. Furthermore, *Itri* clearly states that signals should be made "high enough to compensate for the [isolation circuit] to minimize signal losses." *See Itri*, Col. 8, Lines 5-8. As a result, interpreting the isolation circuit of *Itri* as a "termination circuit" of Claim 45, clearly fails to consider *Itri* as a whole—***as is required by the M.P.E.P.*** Thus, Applicants submit that such an interpretation is improper. Favorable action is requested.

Claim Language

The Advisory Action contends that "it is not clear in the claim language as to whether the tip portion 102 and ring portion 104 signals of telephone line 69 of Figure 4 are passed through the 'termination circuit' or fully absorbed by the 'termination circuit'." *See Advisory Action*, continuation sheet. Applicants respectfully traverse this contention.

First, Applicants respectfully note that the claim language does not recite, for example, "tip portion 102," "ring portion 104," "telephone line 69," or "Figure 4," and thus, the claim is not limited to such example embodiments.

Second, contrary to the Advisory Action's contention, Applicants respectfully note that Independent Claim 1 clearly states "***terminating*** the combined channel with a termination circuit." *See* Claim 1 (emphasis added); *see also* Claim 45 (stating "***terminating*** the combined channel with a termination circuit") (emphasis added); Claim 55 (stating "***terminating*** the combined channel with a termination circuit") (emphasis added); Claim 60 (stating "a termination circuit operable to ***terminate*** the combined channel") (emphasis added); Claim 65 (stating "***terminating*** the combined channel with a termination circuit") (emphasis added); Claim 66 (stating "a termination circuit operable to ***terminate*** the combined channel") (emphasis added). Favorable action is requested.

CONCLUSION

As the rejections of Claims 1-4, 7-16, and 45-66 contain clear deficiencies, Applicants respectfully request a finding of allowance of Claims 1-4, 7-16, and 45-66. To the extent necessary, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

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